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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/829,847	04/10/2001	Stephen Allan Collum	P04984US0	9488
22885	7590	02/27/2004	EXAMINER	
MCKEE, VOORHEES & SEASE, P.L.C. 801 GRAND AVENUE SUITE 3200 DES MOINES, IA 50309-2721			HECKENBERG JR, DONALD H	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/829,847	<b>Applicant(s)</b> COLLUM, STEPHEN ALLAN	
	<b>Examiner</b> Donald Heckenberg	<b>Art Unit</b> 1722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-7 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, drawn to a telescoping form, classified in class 249, subclass 155.

II. Claims 8-10, drawn to a method of providing access to equipment placed under a cement floor, classified in class 264, subclass 35.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group II and Group I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. MPEP § 806.05(e). In this case the apparatus as claimed can be used to practice another and materially different process such as a process forming a void in resin or wax composition, as opposed to forming a void in concrete.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation between Examiner Michelle Lazor and Jeff Harty (Applicant's Representative) on December 31, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by Applicant in replying to this Office action. Claims 8-10 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. The Information Disclosure Statement (IDS) filed April 10, 2001 cites, among other references, U.S. Pat. Nos. 28,715 and 4,988,705. The IDS indicates that the names of the patentees for these patents are Cass and Adams respectively. However, the actual patentee names for these patents are Godfrey and Ganguly et al., and these patents disclose subject matter which does not appear to be relevant to the instant application. Thus, it appears as though the cited patent numbers are not the documents

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Applicant intended to cite. The patents numbers as listed on the IDS have been considered (note the marked copy provided with this Office Action), however it suggested Applicant review the IDS to make sure the intended patents were cited.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Harbeke (U.S. Pat. No. 4,823,527).

Harbeke discloses a form for forming a void in poured concrete. The form comprises an upper section (12) defined by a plurality of sides (see figure 2) and being of plastic composition (col. 3, ll. 26-32). The form also comprises a lower section (48) capable of telescoping into the upper section (col. 4, ll. 10-17). The lower section is also of a plastic composition (col. 3, ll. 55-60).

Harbeke further discloses the form to comprise a lid (3) removably mounted on the upper section of the form (see figures 1-2). The lid comprises a finger hole (72) which would aid in

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gripping and removal of the lid. The form further comprise a lip on the upper section for receiving the lid (the lip being in the form of top surface of the upper section 12 which receives and contacts the lid as shown in figures 1-2).

8. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (U.S. Pat. No. 5,496,213).

Miller discloses a foundation vent which is used to form a void in poured concrete. The vent comprises an upper section (24) defined by a plurality of sides (see figure 5). The vent also comprises a lower section (26) capable of telescoping into the upper section (see figures 6-8). Both the upper section and the lower section are of plastic composition (col. 5, ll. 11-13).

Miller further discloses the vent to comprise a lip (74) on the upper section and a lip (42) on the lower section. The lip on the upper section and the lip on the lower section contact each other in a fully extended telescoping position (figure 6, and col. 5, ll. 1-10).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harbeke.

Harbeke discloses the apparatus as described above. Harbeke further disclose the plastic composition of the upper section to be PVC (col. 3, ll. 26-32). Harbeke does not explicitly disclose that the lower section to be made of PVC. However, Harbeke notes that the lower section is made of standard plastic pipe (col. 3, ll. 55-56), and that PVC is one type of plastic from which plastic pipes are made (col. 3, ll. 28-31). Accordingly, it would have been obvious to one of

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ordinary skill in the art at the time of Applicant's invention to have the plastic composition of the lower section of Harbeke be PVC because this is a standard plastic used for pipes which the lower section of the apparatus comprises as disclosed by Harbeke.

12. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a telescoping form with the combination of features defined in claim 4. The closest prior art disclosed by Harbeke and Miller is described above. Miller does not disclose a lid structure. Harbeke discloses a lid structure, but does not teach or suggest the lid to comprise a plurality of cross ribs.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The



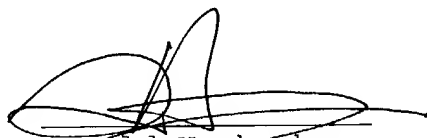
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examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

  
Donald Heckenberg  
February 17, 2004